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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,727	06/17/2002	Hilmar Rauhe	PR-US010482	5285

7590 09/28/2004

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EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/937,727	<b>Applicant(s)</b> RAUHE ET AL.	
	<b>Examiner</b> Channing S Mahatan	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 and 44-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-42 and 44-53 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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*ART UNIT DESIGNATION*

The Group and/or Art Unit designated for this application has changed. Applicants are hereby informed that future correspondence regarding this application should be directed to Group Art Unit 1631.

**Restriction/Election Requirement**

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-8 and 48-50, drawn to a method for producing information-carrying polymers, classified in class 702, subclass 19.
- II. Claims 9, 11-38, 41, 45, and 51-53, drawn to information-carrying polymer, classified in class 702, subclass 20.
- III. Claim 10, drawn to a random number generator, classified in class 702, subclass 22.
- IV. Claims 39 and 40, drawn to a method of encrypting information using nucleic acids, classified in class 536, subclass 25.3.
- V. Claim 42, drawn to a method of labeling using polymers, classified in class 435, subclass 4.
- VI. Claim 44, drawn to a method of manufacturing biologically active molecules by using oligomers, classified in class 435, subclass 91.2.
- VII. Claim 46, drawn to a method of manufacturing biochips using NFR method (Niehaus-Feldkamp-Rauhe method), classified in class 435, subclass 283.1.

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VIII. Claim 47, drawn to a method of manufacturing nano-techogolical components or components of nano-technological modular systems using NFR method (Niehaus-Feldkamp-Rauhe method), classified in class 422, subclass 129.

The inventions are distinct, each from the other because:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the information-carrying polymer of Group II can be made in the distinct processes of the invention of Group I (method for producing information-carrying polymers), or a method of making a nucleic acids, or a method of making polypeptides, wherein nucleic acids and polypeptides are considered to be polymers.

The inventions of Groups (I and II) and III-VIII are independent inventions because they are directed to different inventions having different modes of operation, different functions, or different effects (M.P.E.P. § 806.04, M.P.E.P. § 808.01). In the instant case the different inventions are directed to a method for producing information-carrying polymers and the information-carrying polymers. The mode of operation and mode of function for Group III is to a random number generator (i.e. software program). The mode of operation for Group IV has been interpreted to be directed to a method of encrypting information using nucleic acids. The mode of operation for Group V has been interpreted to be directed a method of labeling using polymers. The mode of operation for Group VI has been interpreted to be directed to a method of manufacturing biologically active molecules by using algomers. The mode of operation of

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Group VII has been interpreted to be directed to a method of manufacturing biochips using NFR method. The mode of operation of Group VIII has been interpreted to be direct to a method of manufacturing nano-technological components or components of nanotechnological modular systems using NFR method. It should be noted Groups V-VIII (claims 39, 40, 42, 44, 46, and 47) have been restricted to the Examiner's best ability, wherein the claims do not set forth any steps involved in the method/process. Further, Applicants are herein warned that the claimed recitation of a use, without setting forth any steps involved in the process may be considered an improper definition of a process, which is improper under 35 U.S.C. § 101. Thus, Groups (I-II) and (III-VIII) have different functions, different effects, and different modes of operation.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art because of their recognized divergent subject matter, and the search for each Group would require a non-coextensive non-patent literature search. Thus, the restriction for examination purposes as indicated above is proper.

Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. § 1.143).

#### *INVENTORSHIP AMENDMENT*

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

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*EXAMINER INFORMATION*

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 C.F.R. § 1.6(d)). The CM1 Fax Center number is either (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Channing S. Mahatan whose telephone number is (571) 272-0717. The Examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify Applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the

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problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables Applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

*Marianne P. Allen*  
MARIANNE P. ALLEN  
PRIMARY EXAMINER 7/22/04

*A41631*

Date: *September 22, 2004*

Examiner Initials: *CSM*